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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/226,107	01/07/1999	YASUNORI WATANABE	102491	1509

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 05/07/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/226,107

Applicant(s)

WATANABE ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 12-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

This communication is responsive to amendment filed on February 26, 2002.

Applicant amends claims 13 and 19.

Response to Applicant's Remarks

1. Applicant remarks that Hayashi fails to disclose the reading section being disposed above the shaft and rotated about the shaft to separate from the recording section.

It is noted that, in Hayashi, "the reading section" is not the sensor 8 but the whole section above the recording unit which is above the shaft 14. Although the sensor is separated from the shaft 14 there is nowhere in the claim that claims the sensor is on the shaft. Clarification is needed by stating "rotatable about said shaft", and how a reading section is rotated about the shaft, since it can be broadly interpret as the reading section is above the shaft and having rollers rotates above the shaft to guide the original document to the sensor 8 in order to scan it. In addition, the purpose why the reading section is disposed above the shaft and rotated above the shaft is to separate from the recording section. Thus, the shaft 14 in Hayashi is also for separating the reading section with the recording section.

The rejection of claims 1-11, is maintained as following.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-7, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al (US Patent No. 5,359,435).

Concerning claim 1, Hayashi et al discloses an apparatus comprising an outer casing having a front side, a rear side and a lower side (Fig. 1); a shaft (14), a recording section. Hayashi further teaches a reading section having a front edge substantially in coincidence with the front side of the outer casing and being disposed above the shaft and rotated about the shaft to separate from the recording section (col. 3, line 47 – col. 4, line 59).

Hayashi does not mention a space is provided above the recording section and below the reading section. However, from Fig. 2, there is a space between the original reader and the ink-jet recording apparatus. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to consider that the original reader being disposed above a shaft and rotated about the shaft to separate from the recording section, whereby a space is provided above the recording section since there is a space between the original reader and the shaft 14.

Concerning claims 2-4, 6, 7, Hayashi further teaches that the reading section is disposed closer to the front side and is rotated toward the front side of the outer casing; the shaft is disposed adjacent to the recording section and disposed nearer the front side of the outer casing; a control panel (2) having a front end substantially in coincidence with the front side of the outer

casing, a rear end opposing the front end, and a lower surface wherein the reading section is disposed on the lower surface of the control panel (col. 5, lines 5-40); the recording section comprises an ink jet printer provided with an ink cartridge (12), (col. 4, lines 35-47); the reading section is disposed adjacent to the recording section and covers at least a portion of the recording section (Fig.2).

Concerning claim 10, Hayashi teaches a discharge port 7 formed in the front surface 1a of the main body 1 after the recording operation of the ink jet recording apparatus for discharging recording paper. Hayashi does not teach a recording discharge tray for holding the discharged paper. However, it was commonly known that a conventional system with printing function have a tray for holding discharged paper. Hayashi discloses a conventional facsimile apparatus comprising discharge tray 54 for holding original document and discharge tray 62 for holding recording paper (Fig.4; col. 1, lines 23-54). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the discharge port to have a discharge tray as in the conventional facsimile apparatus in Fig.4 in order to hold the discharge paper in order and in one fixed place.

4. Claims 5, 8, 9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi as applied to claim 1 above, and further in view of Musso et al (US Patent No. 5,523,848).

Concerning claims 5, 8, 9, Hayashi fails to teach a document holding section that extends from the read end of the control panel for supporting document to be conveyed to the reading section wherein the document holding section is rotatable together with the reading section and

serves as a cover for covering the recording section when not rotated open. It was commonly known in the art that a discharge path for discharging sheet for scanning having a holding means or a tray for holding discharge paper. For instance, Hayashi discloses a conventional facsimile apparatus comprising discharge tray 54 for holding original document and discharge tray 62 for holding recording paper (Fig.4; col. 1, lines 23-54). In addition, Musso et al discloses an ink jet printing device and plain paper facsimile apparatus with a document holding section that extends from the read end of the control panel for supporting document to be conveyed to the reading section wherein the document holding section is rotated together with the reading section and serves as a cover for covering the recording section when not rotated open (Figs. 21-22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teaching of a holding means in Musso et al to the front side surface 1a since both of Hayashi and Musso teaches an upright facsimile machine having the reading section above the recording section while Hayashi teaches that the original reader registers original in their widthwise direction by a guide 4a, moves the originals one by one in a direction of an arrow and reads an original image while discharging the original to an opening portion 3 formed in a front side surface 1a of the main body 1. Thus, the combination will provide a system with a holding tray that can hold discharged paper.

Concerning claim 11, Hayashi fails to teach an urging member wherein the recording paper discharge tray is rotated supported on the outer casing and is supported by the urging member to slant upward. Musso teaches the and additional piece 266 pivoted on one side of the plate 264 with upward direction (Figs.21-22). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teaching of a

holding means in Musso et al to the front side surface 1a since both of Hayashi and Musso teaches an upright facsimile machine having the reading section above the recording section while Hayashi teaches a discharge port 7 formed in the front surface 1a of the main body 1 after the recording operation of the ink jet recording apparatus for discharging recording paper. Thus, the combination will provide a system with a holding tray that can hold discharged paper in an upward direction.

Allowable Subject Matter

5. Claims 12-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. Applicant's arguments filed on February 26 have been fully considered but they are not persuasive. **

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 2622

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
May 3, 2002.